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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/727,197	12/03/2003	R. Bharat Rao	2002P19745US01	4681

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Siemens Corporation  
Intellectual Property Department  
170 Wood Avenue South  
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EXAMINER

FRENEL, VANEL

ART UNIT

PAPER NUMBER

3626

DATE MAILED: 03/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/727,197

Applicant(s)

RAO ET AL.

Examiner

Vanel Frenel

Art Unit

3626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-51 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-51 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### **Notice to Applicant**

1. This communication is in response to the Amendment filed on 12/21/05. Claims 25 and 39 have been amended. Claims 1-51 are pending.

2. Applicant's arguments filed on 12/21/05 regarding the 101 rejection has been persuasive, therefore the 101 rejection is hereby withdrawn.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Evans (6,347,329) in view of (Managed Care: New Financial/ Practice Strategies to Manage More Efficient/ Effectively in a Primary Care Setting by Virginia Smith Harvin; 1998) hereinafter "Virginia" and further in view of (iMedica Creates the Most Comprehensive Charting Solution Harnessing the Power Of the Internet Wirelessly by PR Newswire, N.Y. Jan 18, 2000).

(A) Claim 25 has been amended to recite the limitations of "an electronic database comprising", "of". However, this change does not affect the scope and the breadth of the claim as originally presented/or in the manner in which was interpreted by the Examiner

when applying prior art within the previous Office Action. As, such this claim is rejected under the same reasons given in the prior Office Action, and incorporated herein.

(B) Claim 39 has been amended to recite the limitations of “in a”, “program storage device” and “instructions for”. However, this change does not affect the scope and the breadth of the claim as originally presented/or in the manner in which was interpreted by the Examiner when applying prior art within the previous Office Action. As, such this claim is rejected under the same reasons given in the prior Office Action, and incorporated herein.

(C) Claims 1-24, 26-38 and 40-51 have not been amended are therefore rejected for the same reasons given in the previous Office Action, and incorporated herein.

### ***Response to Arguments***

5. Applicant's arguments filed on 12/21/05 with respect to claims 1-51 have been fully considered but they are not persuasive. Applicant's arguments will be addressed in the same way they appear in the amendment filed on 12/21/05.

(A) At pages 10-15 of the response of 12/21/05, Applicant argues the followings:

(a) Evans does not disclose analyzing with a computer “from at least the unstructured data source” and “automatically extracting billing information from the medical record as part of the analysis”.

(b) Neither Evans nor Harvin disclose analyzing unstructured data with the aid of a device, such as a computer, to automatically extract billing information, such as codes.

(c) Harvin does not disclose automatically generate a medical claim for a patient.

(d) There is no suggestion to automatically update the record with extracted billing information.

(e) There is no disclosure that the billing codes are not based on diagnosis codes.

(B) With respect to Applicant's first argument, Examiner respectfully submitted that He relied upon the clear and unmistakable teaching of PR Newswire for such a feature. Further, PR Newswire discloses in Page 2, Paragraphs 11-12: "Medical encounters are charted on a real-time basis right in the examination room, creating a secure Internet record of the visit. Authorized persons, including consulting physicians and doctors within the same practice who are on call evenings and weekends, have instant access to the chart from any computer connected to the Internet, using a standard browser...etc). Furthermore, PR Newswire suggests "A major benefit of PhysicianSuite is the Superbill. The solution automatically recommends billing codes based on the charting results, and is compliant with reimbursement regulations published by the Health Care Financing Administration (HCFA), which regulates Medicare. This feature assures correct and correct billing is accomplished quickly while providing an audit trail of supporting coding with minimal effort" which correspond to Applicant's claimed

feature (See PR Newswire, Page 3, Paragraph 1). Therefore, Applicant's argument is non-persuasive and the rejection is hereby sustained.

(C) With respect to Applicant's second argument, Examiner respectfully submitted that He relied upon the clear and unmistakable teaching of PR Newswire for such a feature. Further, PR Newswire suggests "Physician Suite goes to the next step of clinical medical practice by creating a legible electronic record for each patient visit, which is then stored on the Internet. The wireless, pen-based computer system contains a knowledgebase tailored to a physician's specialty and addresses common workflow bottlenecks by providing superior documentation, automatic HCFA/Medicare compliant coding and secure records storage" which correspond to Applicant's claimed feature (See PR Newswire, Page 2, Paragraphs 2-3). Therefore, Applicant's argument is not persuasive, and the rejection is hereby sustained.

(D) With respect to Applicant's third argument, Examiner respectfully submitted that He relied upon the clear and unmistakable teaching of PR Newswire for such a feature. Further, PR Newswire suggests "There are few things as personal as one's medical record," said Kathleen A. O'Connor, MBA, healthcare consultant in medical record security. The Health Insurance Portability and Accountability Act (HIPAA) of 1996 mandates security guidelines for electronic applications involving patient personal and medical information. By adopting a multi-layer encryption and a proprietary security control measure, iMedica assures data privacy," O'Connor said. Files are backed up in

the same secure site used by Blue Shield, Kaiser and VISA International to store their sensitive data. Finally, to prevent any data loss, each patient record is stored with multiple redundancy (See PR Newswire, Page 2, Paragraph 12) which correspond to Applicant's claimed feature. Therefore, Applicant's argument is not persuasive and the rejection is hereby sustained.

(E) With respect to Applicant's fourth argument, Examiner respectfully submitted that He relied upon the clear and unmistakable teaching of PR Newswire for such a feature. Further, PR Newswire suggests that "Physician Suite allows me to spend more time confusing on medicine and less time with administrative tasks" said Albert Shen, M.D., active attending physician at Stanford Medical Center, and one of the physician who beta-tested the product. Record –keeping is of extreme importance to quality, and iMedica's solution has made that part of my practice much less time consuming. The HCFA compliant billing codes created by iMedica Physician Suite keep me worry free" which correspond to Applicant claimed feature (See PR Newswire, Page2, Paragraph 3). Therefore, Applicant's argument is not persuasive and the rejection is hereby sustained.

(F) With respect to Applicant's fifth argument, Examiner respectfully submitted that He relied upon the clear and unmistakable teaching of PR Newswire for such a feature. Further, PR Newswire suggests "Physician Suite goes to the next step of clinical medical practice by creating a legible electronic record for each patient visit, which is

then stored on the Internet. The wireless, pen-based computer system contains a knowledgebase tailored to a physician's specialty and addresses common workflow bottlenecks by providing superior documentation, automatic HCFA/Medicare compliant coding and secure records storage" which correspond to Applicant's claimed feature (See PR Newswire, Page 2, Paragraphs 2-3). Therefore, Applicant's argument is not persuasive, and the rejection is hereby sustained.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

### ***Conclusion***


7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vanel Frenel whose telephone number is 571-272-6769. The examiner can normally be reached on 6:30am-5:00pm.



If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 571-272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

V.F  
V.F

  
**ALEXANDER KALINOWSKI**  
**SUPERVISORY PATENT EXAMINER**

March 03, 2006